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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,966	03/08/2004	Gary Marshik	BSI-036	8628
51414	7590	05/01/2006	EXAMINER	
<b>GOODWIN PROCTER LLP</b> <b>PATENT ADMINISTRATOR</b> <b>EXCHANGE PLACE</b> <b>BOSTON, MA 02109-2881</b>				STRIMBU, GREGORY J
ART UNIT		PAPER NUMBER		
				3634

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/795,966	MARSHIK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregory J. Strimbu	3634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
  - 4a) Of the above claim(s) 21-26 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/13/04, 10/5/04, + 6/25/04
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a balance shoe assembly, classified in class 049, subclass 181.
- II. Claims 20-26, drawn to a method of locking and unlocking a balance shoe in a window frame, classified in class 049, subclass 506.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the process for using the product can be practiced by another materially different product such as one that does not include a pivoting locking member.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John V. Forcier on April 24, 2006 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because "[t]he invention relates to" on line 1 can be easily implied and therefore should be deleted. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

Claims 10-14 and 16-20 are objected to because the preamble of the claims does not agree with the preamble of the independent claims from which they depend. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "the locked position" on line 8 of claim 1 render the claims indefinite because it is unclear if the applicant is referring to the locking position set forth above or is attempting to set forth another locked position in addition to the locking position set forth above. It is suggested the applicant change recitations such as "to penetrate" on line 2 of claim 4 to --for penetrating-- to clearly set forth that the applicant is claiming the subcombination of the balance shoe. Recitations such as "a locked position" on line 2 of claim 5 render the claims indefinite because it is unclear if the applicant is referring to the locking position set forth above or is attempting to set forth another locking position in addition to the one set forth above.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 5, 7, 8, 9, 12, 13, 15, 18 and 20 are rejected under 35 U.S.C. 102(b)

as being anticipated by Johnson. Johnson discloses a balance shoe for use in a window jamb comprising a slide block 13, a pivoting locking member 17 coupled to the slide block and biased into a locking position when installed in the jamb, the pivoting locking member comprising a portion (not numbered, but shown in figure 1) extending beyond a lower end of the slide block at least when the pivoting locking member is in the locking position and a camming surface 24 disposed on the pivoting locking member that, upon application of a force, retracts the pivoting locking member from the locked position, the slide block includes oppositely disposed surfaces (not numbered, but shown in figure 4), a spring 22, the block 13 is attached to a window balance cord 8, a window balance (not shown, but see column 2, line 32), a window frame 2 comprising a window jamb (not numbered, but shown in figure 1), a window sash 6 slidable in the window jamb and tilttable with respect thereto.

Claims 1-4, 6-11, 13-17, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansel et al. Hansel et al. discloses a tilt-in window sash assembly, comprising: a frame 16 comprising a window jamb 18; at least one tilt-in window sash

14, the tilt-in window sash operatively slideable in the window jamb and titlable with respect thereto; and at least one window balance (not shown, but see column 4, lines 18-19) coupled to a balance shoe 20 and the window jamb, the balance shoe positionable in the window jamb and comprising: a slide block 22; a pivoting locking member 24 coupled to the slide block and biased into a locking position when installed in the jamb and the window sash is pivoted, the pivoting locking member comprising a portion (not numbered, but shown in figure 3) extending beyond a lower end of the slide block at least when the pivoting locking member is in the locking position: and a camming surface (not numbered, but shown as the surface upon which the pivot bar 34 is resting in figure 5) disposed on the pivoting locking member that, upon application of a force, i.e., the window sash pivoting in to the sliding position, retracts the pivoting locking member from the locked position, oppositely disposed sliding surfaces (not numbered, but shown in figure 5), teeth 28, a pivot bar 34.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anderson, Uken et al., O'Donnell et al., Goldenberg, Osten, and Adams are cited for disclosing a balance shoe having a locking member disposed below a lower surface of the balance shoe.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-

Art Unit: 3634

272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
April 27, 2006